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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PATTERSON, MARC A

ART UNIT PAPER NUMBER

1772

DATE MAILED: 04/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,688

Applicant(s)

SHIRASAKI, TORU

Examiner

Marc A Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

~~Response to Arguments~~

Final

1. In view of the appeal brief filed on December 22, 2003, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

WITHDRAWN REJECTIONS

2. The 35 U.S.C. 112, second paragraph rejections of Claims 8 – 14, of record on pages 2 – 3 of the previous Action, are withdrawn.

The 35 U.S.C. 102(b) rejection of Claims 8 – 14 as being anticipated by Yen (U.S. Patent No. 4,470,508), of record on page 4 of the previous Action, is withdrawn.

NEW REJECTIONS

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 8 – 10 are rejected under 35 U.S.C. 102(b) as being ^{anticipated} by Beldyk (U.S. Patent No. 5,042,655).

With regard to Claims 8 and 10, Beldyk discloses a container (package; column 2, line 60) for a framed pellicle (column 2, lines 62 – 63) comprising a base (bottom member; column 2, line 61), a covering for the casing which is mounted on the lower member (upper member; column 2, line 61), and an inside space between the casing and covering in which the pellicle is housed (the pellicle is housed within the box; column 2, line 60). The packaging material from which the base and covering are made comprises metallized plastic (column 5, lines 48 – 58) and therefore a first surface of the base and covering comprise metal.

With regard to Claim 9, the container base and covering consist of metal (column 5, lines 52 – 54).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beldyk (U.S. Patent No. 5,042,655).

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Beldyk discloses a container comprising a base and covering comprising a first surface comprising an inorganic material comprising metallized plastic as discussed above. With regard to Claim 11, Beldyk fails to disclose a second surface comprising inorganic material. However, Beldyk teaches that the first surface comprises inorganic material for the purpose of dissipating static charge (column 5, lines 51 – 52). One of ordinary skill in the art would therefore recognize the advantage of providing for a second surface which comprises metal, depending on the number of surfaces which are desired to have static dissipation in the end product as taught by Beldyk.

sum It therefore would have been obvious ^{to} ~~for~~ one of ordinary skill in the art at the time Applicant's invention was made to have provided for an additional surface which comprises metal in Beldyk depending on the number of surfaces for which static dissipation is desired.

sum With regard to Claim 12, Beldyk fails to disclose a metallized layer having a thickness of at least 0.1 μm . However, Beldyk discloses a layer having a total thickness of 0.05 to 0.1 inches (column 7, lines 5 – 6). ~~Therefore~~ ^{One} one of ordinary skill in the art would have recognized the utility of varying the thickness depending on the static dissipation of the desired end product as taught by Beldyk. *sum* Therefore, ^{a suitable} ~~the~~ thickness would be readily determined through routine optimization of thickness by one having ordinary skill in the art depending on the desired end use of the product.

It therefore would be obvious for one of ordinary skill in the art to vary the thickness in order to obtain a static dissipation, since the thickness would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as

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shown by Beldyk, in the absence of unexpected results. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

With regard to Claim 13, Beldyk fails to disclose a metallized plastic comprising aluminum. However, Beldyk teaches the use of aluminum as a metal of the invention, for protection of the pellicle (the frame comprises aluminum; column 2, lines 62 – 65). It would therefore ^{have been} obvious to one of ordinary skill in the art to provide for aluminum as the metal of the metallized plastic, for the purpose of protecting the pellicle as taught by Beldyk.

With regard to Claim 14, the metallized plastic would therefore also comprise alumina.

ANSWERS TO APPLICANT'S ARGUMENTS

9. Applicant's arguments regarding the 35 U.S.C. 112 second paragraph rejections of Claims 8 – 14 and 35 U.S.C. 102(b) rejection of Claims 8 – 14 as being anticipated by Yen (U.S. Patent No. 4,470,508), of record in the previous Action, have been considered and have been found to be persuasive. The rejections are therefore withdrawn. The new 35 U.S.C. 102(b) rejection of Claims 8 – 10 as being by Beldyk (U.S. Patent No. 5,042,655) and 35 U.S.C. 103(a) rejection of Claims 11 – 14 as being unpatentable over Beldyk (U.S. Patent No. 5,042,655) are directed to Claims 8 – 14.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (703) 305-3537. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If

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attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (703) 308-4251. FAX communications should be sent to (703) 872-9310. FAXs received after 4 P.M. will not be processed until the following business day.

Marc A. Patterson, PhD.

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SANDRA M. NOLAN
PRIMARY EXAMINER